

described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).] "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

That is not the case here. Behr does not teach using the **specific combination** of L-carnitine, chromium, Vitamin A and a *carbohydrate source* comprising a *low glycemic index grain for the purpose of achieving weight loss*. Behr is directed to a liquid nutritional product for providing nutrition to patients who are ill or unable to swallow food and requires only a source of fermentable fibers, a source of non-fermentable fibers, and a fat source.

Behr does not teach or suggest a **carbohydrate** source comprising **low** glycemic index **grain** as claimed. Rather, Behr teaches a carbohydrate source comprising hydrolyzed corn starch. As disclosed in U.S. Patent No. 5,968,896 (copy enclosed), corn starch which is heated is broken down into simple carbohydrates, resulting in a product having a high glycemic index (see paragraph bridging columns 3-4). As Behr teaches heating his carbohydrate/mineral slurry to temperatures ranging from 140° to 160°F (see col. 6, lines 61-68 and col. 7, lines 1-16), it is believed that Behr's carbohydrate source would not have a low glycemic index as required in applicants' claims. See also the enclosed pages from Food Product Design which disclose that corn syrup, which comprises partially hydrolyzed corn starch, is broken down into a variety of simple sugars. Simple sugars would be high glycemic index compositions.

Nor does Behr's carbohydrate source qualify as a grain. Corn starch is not a grain, i.e., a small hard seed or fruit produced by a cereal grass. See the enclosed definition from the American Heritage Dictionary, Second College Edition. And, while Behr discloses the use of barley glucans and corn bran, these are taught as **fiber** sources, not carbohydrate sources as claimed.

Further, as previously pointed out, Behr is directed to a **high** calorie formulation and discloses a preferred calorie content of 245 to 255 Kcal per serving (see Table XV). Behr would clearly not inherently provide weight loss. Claims 1 and 8 are clearly patentable over Behr.

Claims 1, 3-5, 8, 9, and 14 have been rejected under 35 USC § 103(a) as being unpatentable over US Patent No. 5,626,849 to Hastings, the Purina CNM Veterinary Product Guide (1994), and US Patent No. 5,240,962 to Nakatsu et al. The Examiner maintains that Nakatsu '962 teaches that corn, sorghum, wheat and barley "can be used interchangeably as a carbohydrate source in weight loss compositions", and that one skilled in the art would have a reasonable expectation that sorghum, wheat, and barley could be used as a carbohydrate source "as taught by the Purina Product Guide", and that chromium and L-carnitine could be added to this composition "based on the disclosure by US '849 that these ingredients lower weight".

As previously pointed out, there is no motivation or suggestion in the references to combine the components disclosed in the references in a single composition for the purpose of achieving a weight loss composition. The examiner is using impermissible hindsight to create the claimed combination from the reference teachings. Nothing in the Purina Product Guide teaches or suggests using vitamin A for weight loss, and the canned ingredients listed on p. 17 do not even include vitamin A.

And, as previously pointed out, Nakatsu does not teach the above grains as a **carbohydrate source** having a **low glycemic index** for use in a composition for weight loss. Rather, the grains are taught as an **animal feed** for use in mixing **with** the active fat-reducing compound for administration to the animal. There is no teaching in Nakatsu which would motivate one skilled in the art to use animal feed as a carbohydrate source in a composition for promoting weight loss. The Examiner asserts that "US '962 clearly states that corn, sorghum, wheat, and barley are suitable carbohydrate sources to use in weight loss compositions." The Examiner is respectfully requested to point to the passage in Nakatsu which discloses this.

There is clearly no motivation for one skilled in the art to pick and choose components from a dietary supplement for humans (Hastings) and combine them with a high fiber diet for dogs (Purina) which may or may not contain vitamin A. Nor would one look to the teachings of Nakatsu, who do not teach the use of a carbohydrate source comprising a low glycemic index grain to promote weight loss.

For all of the above reasons, applicants submit that claims 1, 3-5, 8-9, and 14 are patentable over the cited art of record. Early notification of allowable subject matter is respectfully solicited.

Respectfully submitted,
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